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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/539,726 | 07/19/2006 | Sergey Amontov | CH920020037US1 | 8613 |
| 48062 7590 03/24/2008 RYAN, MASON & LEWIS, LLP 1300 POST ROAD SUITE 205 FAIRFIELD, CT 06824 | | | | |
| EXAMINER | | | | |
| BERTAGNA, ANGELA MARIE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1637 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 03/24/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,726

Applicant(s)

AMONTOV ET AL.

Examiner

ANGELA BERTAGNA

Art Unit

1637

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-17 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-17 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. Applicant's response filed on December 19, 2007 is acknowledged. Claims 1, 4-17, and 20-23 are currently pending. In the response, Applicant amended claims 1 and 8 and cancelled claims 2, 3, 18, and 19. Claim 23 is withdrawn as being drawn to a non-elected invention.

Applicant's arguments regarding the previously made rejections have been fully considered and are persuasive. The previously made rejections have been withdrawn. The following are new grounds of rejection not necessitated by the amendments to the claims. Accordingly, this Office Action is non-final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4-7, 9, 10, 14-17, and 20-22 rejected under 35 U.S.C. 102(b) as being anticipated by Church (US 6,432,360 B1; newly cited).

These claims are drawn to a method for producing a monolayer of molecules on a surface comprising transferring seed molecules from a stamp to the surface and producing the monolayer via an amplification reaction.

Regarding claim 1, Church teaches a method for producing a monolayer of molecules on a surface (see columns 8-15) comprising:

- (a) loading a stamp with seed molecules (column 15, lines 1-55)
- (b) transferring seed molecules from the stamp to the surface, wherein the transferring comprises transferring a fraction of the seed molecules loaded on the stamp to the surface and adsorbing the seed molecules to the surface (column 15, lines 52-55)
- (c) self-completing amplification of the seed molecules via an amplifying reaction to produce the monolayer (column 15, line 56 teaches amplification of the transferred seed molecules; see column 13, line 58 – column 14, line 67 for further description).

Further regarding claim 1, since not all of the seed molecules are transferred during the microcontact printing step (see column 15), the adsorption of the seed molecules to the stamp is inherently stronger than the adsorption of the seed molecules to the surface.

Regarding claim 4, Church teaches that the amplification comprises linear amplification of the seed molecules (see column 14, where the reverse transcription step is a linear amplification).

Regarding claims 5 and 14-16, Church teaches PCR amplification of the seed molecules (column 13, lines 60-65 and column 14, lines 8-12), which is an exponential amplification method. Church further teaches that this method comprises binding at least one primer to the surface and supplying a primer in solution (see columns 13-14).

Regarding claims 6, 7, 9, and 10, the PCR amplification taught by Church is a directional amplification method that is inherently controlled by the geometry of the seed molecules. The amplification is also controlled by application of an external force, specifically heating (see, for example, columns 13-14). Finally, the nucleic acids amplified by the method of Church are inherently conductive structures.

Regarding claim 17, Church teaches *in vitro* translation to generate a protein monolayer (column 9, lines 10-15).

Regarding claim 20, the monolayer produced by Church inherently protects the surface from etchants.

Regarding claim 21, Church teaches that the monolayer comprises DNA (see, for example, column 15, lines 37-56).

Regarding claim 22, Church teaches repeating the transferring and amplifying steps on a plurality of surfaces before reloading the stamp with seed molecules (column 3, lines 58-63).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Church (US 6,432,360 B1; newly cited) in view of Richter et al. (Advanced Materials (2000) 12(7): 507-510; newly cited).

Claim 8 is drawn to the method of claim 6, further comprising electroless plating of the directionally amplified seed molecules with a metal.

Church teaches the method of claims 1, 4-7, 9, 10, 14-17, and 20-22, as discussed above.

Church does not teach electroless plating of the directionally amplified seed molecules with a metal.

Richter teaches that DNA molecules can be metallized and electrolessly plated to form useful nanostructures such as nanowires (see pages 508-510).

It would have been *prima facie* obvious for one of ordinary skill in the art at the time of invention to apply the teachings of Richter to the method taught by Church. An ordinary artisan would have been motivated to metallize and electrolessly plate the amplified nucleic acids on the replica plate of Church as taught by Richter in order to obtain the ability to generate useful nanostructures, such as nanowires. Thus, the method of claim 8 is *prima facie* obvious over Church in view of Richter.

6. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Church (US 6,432,360 B1; newly cited) in view of Korlach et al. (US 2003/0044781 A1; cited previously).

Claims 11 and 13 are drawn to the method of claim 10, wherein the directional amplification of the seed molecules is controlled via application of an electric force or a hydrodynamic force, respectively.

Church teaches the methods of claims 1, 4-7, 9, 10, 14-17, and 20-22, as discussed above.

Church does not teach controlling the amplification reaction with an electrical or hydrodynamic force.

Korlach teaches a method for producing a monolayer of molecules on a surface, comprising: (a) loading a stamp with seed molecules, (b) transferring the seed molecules from the stamp to the surface, and (c) directionally amplifying the seed molecules to produce the monolayer (see Figure 1 and paragraph 39).

Regarding claims 11 and 13, Korlach teaches that the directional amplification is controlled by application of an external force, specifically an electrical or hydrodynamic force (see paragraph 60, where the nucleotide substrates used in the amplification process are supplied by electrical or hydrodynamic forces).

It would have been *prima facie* obvious for one of ordinary skill in the art at the time of invention to control the directional amplification step in the method taught by Church by applying any force known to be useful for controlling amplification, such as the electric and hydrodynamic forces taught by Korlach. An ordinary artisan would have recognized that these forces were art-recognized equivalents useful for achieving the same purpose, namely controlling directional amplification, and therefore, would have been motivated to substitute one for the other with a reasonable expectation of success. Also, see MPEP 2144.06, which states that the substitution of art-recognized equivalents known to be useful for the same purpose is *prima facie*

obvious. Thus, the methods of claims 11 and 13 are *prima facie* obvious over Church in view of Korlach in the absence of secondary considerations.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Church (US 6,432,360 B1; newly cited in view of Mian et al. (US 5,686,271; cited previously).

Claim 12 is drawn to the method of claim 10, wherein the directional amplification reaction is controlled via application of a magnetic force.

Church teaches the method of claims 1, 4-7, 9, 10, 14-17, and 20-22, as discussed above.

Church does not teach that the amplification is controlled by an applied magnetic force.

Mian teaches a method for conducting PCR using magnetic fields termed a “magnetic cycle reaction” or MCR. The MCR method taught by Mian comprises assembling a PCR reaction mixture, conducting multiple cycles of denaturation, annealing, and extension using an electromagnetic field to effect strand separation (see Example 7, column 16, line 50 – column 18, line 9). In the method of Mian, one primer is immobilized on a surface and the other primer is supplied in solution (see Example 7, column 16, lines 50-66, where one primer is immobilized on the bottom of a well of a microtiter plate and the other primer is added in solution).

Regarding claim 12, the PCR amplification taught by Mian is controlled by application of a magnetic field (see Example 7, column 16, line 50 – column 18, line 9).

Mian teaches that magnetic control of PCR amplification has a number of advantages relative to conventional PCR, where high temperatures are used to denature double-stranded DNA targets. Specifically, Mian teaches that the use of electromagnetism for strand separation eliminates the need to use a thermophilic polymerase in the PCR reaction and permits the use of

mesophilic polymerases. Mian teaches that this is advantageous, because mesophilic polymerases have higher fidelity, faster extension rates, and greater processivity than their thermophilic counterparts, thus resulting in a faster, more accurate amplification process that is capable of amplifying longer targets (column 2, lines 19-45).

It would have been *prima facie* obvious for one of ordinary skill in the art at the time of invention to substitute the MCR reaction as taught by Mian for the conventional PCR amplification taught by Church. An ordinary artisan would have been motivated to do so, since Mian taught that electromagnetic denaturation permitted the use of mesophilic polymerases with higher fidelity, faster extension rates and greater processivity than their thermophilic counterparts, thus resulting in a faster, more accurate amplification process capable of amplifying longer templates (column 2, lines 19-45). Thus, the method of claim 12 is *prima facie* obvious over Church in view of Mian.

Response to Arguments

8. Applicant's arguments, see page 7, filed on December 19, 2007, with respect to the rejection of claims 1, 2, 4, 6, 7, 9, and 20 under 35 U.S.C. 102(b) as being anticipated by Hawker, have been fully considered and are persuasive. Hawker does not teach all of the elements of the amended claims, and therefore, this rejection has been withdrawn.

Applicant's arguments, see page 8, filed on December 19, 2007, with respect to the rejection of claims 1, 2, 5-7, 9-11, 14, and 21 under 35 U.S.C. 102(b) as being anticipated by Maracas, have been fully considered and are persuasive. Maracas does not teach all of the elements of the amended claims, and therefore, this rejection has been withdrawn.

Applicant's arguments, see page 9, filed on December 19, 2007, with respect to the rejection of claims 1, 2, 4, 6, 7, 9, 17, and 21 under 35 U.S.C. 102(e) as being anticipated by Fang, have been fully considered and are persuasive. Fang does not teach all of the elements of the amended claims, and therefore, this rejection has been withdrawn.

Applicant's arguments, see page 10, filed on December 19, 2007, with respect to the rejection of claims 1, 2, 4, 6, 7, 9-11, 13, 21 under 35 U.S.C. 102(e) as being anticipated by Korlach, have been fully considered and are persuasive. Korlach does not teach all of the elements of the amended claims, and therefore, this rejection has been withdrawn.

Since the all of the previous rejections made under § 102 have been withdrawn, the rejections made under § 103(a) citing Hawker or Maracas as the primary reference have also been withdrawn.

The provisional statutory double patenting rejection citing Application Serial No. 11/154,965 has been withdrawn in view of the abandonment of the '965 application.

Conclusion

9. No claims are currently allowable.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Turner et al. (US 5,948,621) teaches a method for stamping nucleic acids or proteins on a surface (columns 2-3). Bernard et al. (US 2004/0203085 A1) teaches a method for the repetitive stamping of molecules such as nucleic acids (see abstract and paragraphs 6-17).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANGELA BERTAGNA whose telephone number is (571)272-8291. The examiner can normally be reached on M-F, 7:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Horlick/
Primary Examiner, Art Unit 1637

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